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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,096	09/22/2003	Shelton L. Palmer	54317-011901	2930

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EXAMINER

BAROT, BHARAT

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/668,096	PALMER ET AL.	
	Examiner	Art Unit	
	Bharat N Barot	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claim 57 is presented for examination.

Reissue Formalities

2. The original patent appears to have been printed with additional errors not corrected by the certificate of correction. Col. 5, lines 33-34, "in" and "synchronously" appear to be at odds. Col. 5, line 51, "ULR" is a typographical error. Col. 8, line 6, "a" is a typographical error. Applicants are requested to correct these problems from the original patent in accordance with MPEP § 1453.
3. To date, applicants' amendments to the claims have not been compliant with 37 CFR § 1.173 (c) in that applicants' have made amendments without an explanation of the support in the disclosure of the patent for the changes made to the claims on a separate page. Future amendments should comply with this rule.

Oath/Declaration

4. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error that is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and see MPEP § 1414.
5. Applicants' declaration did not identify at least one *proper* error other than one related to a matter of recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. However, this error has been held to be improper and therefore, applicants' declaration remains defective until a proper error is identified.

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6. Applicants are advised that they must submit a complete and proper reissue declaration to correct the problem noted above.

7. Claim 57 is rejected as being based upon a defective reissue declaration, under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Abstract

8. The abstract of the disclosure is objected to because the abstract does not accurately reflect the wide-ranging scope of applicants' current claims. Correction is required. See MPEP § 608.01(b).

Specification

9. The attempt to incorporate subject matter into this application by reference to the provisional application 60/008,111 is improper because applicants are attempting to incorporate essential material necessary to describe the claimed invention of the instant application. As applicants are attempting to incorporate by reference at Col. 8, lines 33-34 of USP 5,905,865 with a mere reference to the provisional application, such reference "is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 USC § 112, 1st paragraph." *In re Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973) and MPEP § 608.01(p). Since the referenced application has not been published, applicants "are required to amend the disclosure of the instant application to include the material incorporated by reference. The amendment must be accompanied by an affidavit or

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declaration executed by the applicant(s), or a practitioner representing the applicant(s), stating the amendatory material consists of the same material incorporated by reference in the referencing application.” (See MPEP § 608.01(b) (1).)

10. The specification is objected to because of the following informalities:

- a. The reissue application is a divisional of the copending reissue application 09/860,259. The cross-reference information is missing on the first page of the specification. (See 37 CFR 1.177 (a))
- b. Applicant files more than one application for the reissue of a single patent. The claims of the original patent are missing. (See 37 CFR 1.177 (b))

Appropriate corrections are required.

Claim Rejections - 35 USC § 112, 2d paragraph

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 57 recites “a method of hard copy literature request” in a preamble, but the method of steps recited in a body of the claim 57 do not direct or support the method of hard copy literature request.

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Claim Rejections - 35 U.S.C. § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 U.S.C. § 102

13. Claim 57 is rejected under 35 U.S.C. § 102(e) as being anticipated by

Throckmorton et al, patent no. 5,818,441.

57. A method of hard copy literature request comprising:	Throckmorton et al teaches a method of hard copy literature (text and graphic layout through printer) request [44, figures 2 and 4, column 3 lines 35-66, and column 9 lines 15-25].
transmitting broadcast programming, the broadcast programming containing television programming;	transmitting broadcast programming [2, figure 1 and 30, figures 2 and 4], the broadcast programming containing television programming [column 4 lines 6-20 and column 5 line 65 to column 6 line 20].
permitting receipt of an Internet address, wherein the Internet address specifies a web site related to a product or service; permitting retrieval of the web site; and	permitting receipt of an Internet address (URL), wherein the Internet address specifies a web site related to a product or service and retrieval of the web site [column 7 lines 41-45, column 8 lines 15-24, and column 8 line 53 to column 9 line 22].
permitting a user to manually or automatically request information from a class of content provider or a specific content provider through the web site.	permitting a user to manually request information from a specific content provider through the web site [column 8 lines 30-34 and column 9 lines 1-22].

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Contact Information

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bharat Barot whose telephone number is (571) 272-3979. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, can be reached at (571) 272-3978.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Patent Examiner Bharat Barot

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December 06, 2004

Bharat Barot.
BHARAT BAROT
PRIMARY EXAMINER

*MTA, HUSAIN ALAM
SPE, 2155*